



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,664	01/13/2006	Stefan Bachstein	4091.012	1697
37999 7590 06/18/2008 24IP LAW GROUP USA, PLLC 12 E. LAKE DRIVE ANNAPOLIS, MD 21403				
EXAMINER				
MCCLELLAND, KIMBERLY KEIL				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
06/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,664

Applicant(s)

BACHSTEIN, STEFAN

Examiner

KIMBERLY K. MCCLELLAND

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, drawn to a method for manufacturing a laminate.

Group II, claim(s) 10-17, drawn to a device for manufacturing a laminate.

Group III, claim(s) 18-25, drawn to a method for manufacturing a laminate.

Group IV, claim(s) 26-29, drawn to a device for manufacturing a laminate.

Group V, claim(s) 30, drawn to a synthetic/metal laminate.

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4). The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim as defined in PCT Rule 6.4. One example of this is a claim referring to a claim of a different category (for example, "Apparatus for carrying out the

Art Unit: 1791

process of Claim 1 ...,” or “Process for the manufacture of the product of Claim 1 ...”).

Similarly, a claim to one part referring to another cooperating part, for example, “plug for cooperation with the socket of Claim 1 ...”) is not a dependent claim. See MPEP 1850.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

3. Group I does not contain a special technical feature. Every limitation disclosed in independent claim 1 can be found in European Patent Application No. 1044796 to Krenn, including providing at least one continuous process foil (2) depositing a continuous, substantially non-polymeric semi-manufactured product band (1) to the process foil (2) sealing the semi-manufactured product band (1) with respect to the process foils (2) depositing a hardenable synthetics (4) to the semi-manufactured product band (1) hardening the synthetics, while providing a bonding between the synthetics and the semi-manufactured product (see Figure 4, and paragraph 0012). Consequently, Group I is not found to contain a special technical feature.

4. Group II does not contain a special technical feature. Every limitation disclosed in independent claim 10 can be found in European Patent Application No. 1044796 to Krenn, including material storage(s) (8) for continuous dispensing of at least one process foil (2), a storage dispensing device (7) for continuous provision of a substantially non-polymeric semi-manufactured product band (1), a sealing device (6) for sealing the semi-manufactured product with respect to the process foil, as well as a device (5) for storing and dispensing of hardenable synthetics (4) in a continuous manner (see Figure 4, and paragraph 0012). Consequently, Group II is not found to contain a special technical feature.

5. Group III does not contain a special technical feature. Every limitation disclosed in independent claim 18 can be found in European Patent Application No. 1044796 to Krenn, including providing a support surface (2) having predetermined dimensions, depositing a substantially non-polymeric semi-manufactured product band (1) to the support surface (2) sealing the semi-manufactured product band (3) with respect to the support surface (2) depositing a hardenable synthetics (4) to the semi-manufactured product band (1) hardening the synthetics while depositing a bonding between the synthetics and the semi-manufactured product (see Figure 4, and paragraph 0012). Consequently, Group III is not found to contain a special technical feature.

6. Group IV does not contain a special technical feature. Every limitation disclosed in independent claim 26 can be found in European Patent Application No. 1044796 to Krenn, including a support surface (1) having predetermined dimensions, a storage

Art Unit: 1791

dispensing device (7) for providing a substantially non-polymeric semi-manufactured product band (1), a sealing device (6) for sealing the semi-manufactured product with respect to the support surface, as well as at least one laminating facility (5) which may be moved relative to the support surface (2), for storing and dispensing of hardenable synthetics (see Figure 4, and paragraph 0012). Consequently, Group IV is not found to contain a special technical feature.

7. Group V does not contain a special technical feature. Every limitation disclosed in independent claim 30 can be found in European Patent Application No. 1044796 to Krenn, including Synthetics/metal laminate (See Figure 1), which is manufactured according to one of claims 1 to 9 or 18 to 25 and/or by means of a device according to one of the claims 10 to 17 or 26 to 29 (See Figure 4). It is inherent a laminate composed of the same material and produced by the same method would result in a laminate which especially does not show any deformation during ballistic impact with spheres having a diameter of 20 mm at a velocity of 20 m/s. Consequently, Group V is not found to contain a special technical feature.

As a result, there is no common special technical feature between Groups I-V, and the inventions therefore lack unity.

8. Due to the complexity of the current restriction requirement, a telephone call was not made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

9. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise

require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

Art Unit: 1791

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. M./
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791